



Paper No. 6

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SEP 12 2002

OFFICE OF PETITIONS

In re Application of  
Andrew Gilbert  
Application No. 10/042,371  
Filed: December 27, 2001  
Attorney Docket Number: CF-46

DECISION REFUSING STATUS  
UNDER 37 C.F.R. §1.47(b)

This is in response to the petition under 37 C.F.R. §1.47(b), filed July 15, 2002.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on December 27, 2001, without an executed oath or declaration, and naming Andrew Gilbert as sole inventor. Accordingly, on February 14, 2001, a Notice to File Missing Parts of Application - Filing Date Granted was mailed, requiring applicant to submit an executed oath or declaration and pay a surcharge for late filing. The Notice set an extendable two month period for reply.

In reply, applicant filed the instant petition (and fee), the surcharge for late filing of the declaration, a declaration and a three month request for extension of time.

A grantable petition under 37 C.F.R. §1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is necessary to preserve the rights of parties or to prevent irreparable damage. Rule 47 applicant has failed to establish (1), (2), (5) and (6).

#### **Proof of Refusal to Sign the Oath or Declaration**

As to item (1), Rule 47 applicant has failed to show that the legal representative of Andrew Gilbert refused to sign the declaration after having been presented with the application papers. Pursuant to 37 CFR 1.42 the legal representative of the deceased inventor may make the necessary oath or declaration. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The statement of facts indicates only the declaration and assignment documents were sent to Ann Gilbert. Ms. Gilbert as the presumed legal representative must be presented with the opportunity to sign the application papers before rule 47 status will be granted.

**An Acceptable Oath or Declaration**

As to item (2), although petitioner submitted a declaration signed by Howard Lutnick, it does not provide sufficient information. The granting of 47 status requires a rule 47 (b) applicant to make the oath required by 37 CFR §1.63 and §1.64. An officer of a corporation normally is required to sign the oath or declaration. The declaration required must state the full name, residence, post office address, and citizenship of the non-signing inventor. The title or position of the person signing must also be stated if signing on behalf of a corporation under 37 CFR §1.47(b). See MPEP 409.03(b).

**Proof of Proprietary Interest**

As to item (5), proprietary interest is usually found by establishing a) the invention has been assigned to applicant, or b) the inventor has agreed in writing to assign the invention to the applicant or c) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. See MPEP 409.03(f). Rule 47 applicant indicates proprietary interest is established through the employment contract between eSpeed, Inc. and Andrew Gilbert. However, the excerpt of the contract provided in the petition is not sufficient to establish proprietary interest in this application. Rule 47 applicant may wish to submit the employment contract in its totality.

**Showing That Such Action Is Necessary to Preserve the Rights of Parties or to Prevent Irreparable Damage.**

As to item (6), applicant has failed to provide a statement that the granting of rule 47 status is necessary to preserve the rights of the rule 47 applicant or prevent irreparable damage. See MPEP 409.03(h).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
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Telephone inquiries regarding this decision should be directed to Petitions Attorney Charlema R. Grant at (703) 305-0309.

  
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